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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,037	02/26/2002	Meang K. Chia	B-4496PCT 619513-8	9827

36716 7590 05/16/2005

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EXAMINER

MITCHELL, KATHERINE W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,037

Applicant(s)

CHIA

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 131-137 and 139-147 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 131-137, 139-142 and 145-147 is/are rejected.
7) ☒ Claim(s) 143 and 144 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 2/11/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. The applicant could not claim the priority of 09/224,936 in PCT/US00/18389 (at least not during the International stage of this application). Any such claim in the international application is governed by the Paris Convention, which limits any such priority claim, to no more than 12 months previous to the PCT filing date.

PCT/US00/18389 was filed on 30 June 2000 and 09/224,936 was filed on 18 June 1998. No possibility of a priority claim in the PCT filed on 30 June 2000. This is because Article 8 of the PCT clearly states that the conditions for and the effect of any such priority claim are governed by the Paris Convention. Thus, so the record is clear, PCT-US00/18389 is NOT a continuation in part of US application 09/224,936.

However, upon national stage entry of this application into the US, the Paris Convention no longer governs the conditions for and the effect of a priority claim in the national stage application -- US law and regulations govern the conditions for and the effect of any priority claim in the US national stage. This is also mandated by Article 8 of the PCT --because the applicant is in the US national stage and the priority claim in question is to a prior US application. Now it is US law that governs the conditions for and the effect of this priority claim and US law probably permits the claim.

The claim must be made under the conditions of 35 USC 365(c) and 35 USC 120. Note that 09/224,936 was pending as of the international filing date of PCT/US00/18389. 09/224,936 went abandoned in the US on 18 June 2001, while the PCT application was filed on 30 June 2000. The applicant can make the priority claim

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in the national stage of PCT/US00/18389 even though the claim never appeared in the PCT application.

The PCT application was filed before 29 November 2000 (the effective date of the AIPA) so there will be no automatic pre-grant publication for this case. International applications filed on or after 29 November 2000 are subject to the pre-grant publication rules and any domestic priority claim in the national stage of one of those cases would have to have been made in the national stage application within 4 months of the start of the 371 processing (the 371 receipt date -- not the 371 c date). This doesn't apply to this case because it was filed as an international application before the effective date of the AIPA.

Claim Objections

2. Claims 134-137 and 142 and 146-147 are objected to because of the following informalities: as stated in the earlier office action, "plate-shaped" can encompass numerous shapes and thus is indefinite – almost any shape can be considered shaped like a plate:

plate (plāt) *noun*

1. A smooth, flat, relatively thin, rigid body of uniform thickness.
2. a. A sheet of hammered, rolled, or cast metal. b. A very thin applied or deposited coat of metal.
3. a. A flat piece of metal forming part of a machine: *a boiler plate*. b. A flat piece of metal on which something is engraved.
4. a. A thin piece of metal used for armor.¹

¹Excerpted from *The American Heritage Dictionary of the English Language, Third Edition* Copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from Lernout & Hauspie Speech Products N.V., further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

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While "flat" or "planar" can be considered are describing a shape in one direction, the perimeter of an item also describes the shape. Appropriate correction is required.

3. Claim 145 is objected to because of the following informalities: Claim 145 recites a base member segmented into a plurality of segments, each segment having a hollow interior and a top with an opening, and also a plurality of decorative inserts for insertion through **said** opening and fixed within **said** segment hollow interior. There are multiple openings and multiple segments with hollow interiors. Nothing in the claim requires an insert in a respective segment – can one segment have all inserts and some segments have no inserts? Based on the drawings, examiner is assuming that each insert goes into a separate base member segment, especially since each insert is described as fixed within said insert and viewable through said top opening.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 131-133, 136, 139-141 and 146-147 are rejected under 35 U.S.C. 102(b) as being anticipated by Karmeli USP 5454234.

Re claim 131: Karmeli teaches the a decorative jewelry item comprising:

a base member with hollow interior, top with opening, bottom, and sidewall (Fig 1B, 2,4, and 5) (top and bottom are considered to be areas).

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a decorative inert smaller than said opening, for being inserted thru opening into hollow interior and positioned entirely below top (col 3 lines 45-62, Figs 4 and 5)

said decorative insert fixed within said hollow base, said insert is viewable through said top opening (col 3 lines 45-62, Figs 4 and 5, col 3 lines 40-44, col 1 lines 32-33). Col 2 lines 7-8 disclose both the method and structure that the decorative insert (one or more inner stones) may be loosely or **firmly held** within the body cavity (after the cover 14 is attached). **Firmly held** inherently teaches that the decorative member is fixed to the interior. Examiner notes that applicant uses fixed to include rotatably fixed and slidably fixed, so absolute immobility is not required.

Re claims 132-133: Col 3 lines 51-55 teach that the inner stones may be set in a gold setting prior to insertion into the hollow base member to adjust the stone/insert to the desired height relative to the sidewalls, and the actual lower stone portion 18 can be considered the support member. Without this support portion 18, the bottom would be an opening. The stone/inserts are captured between this support member and the top when the cover 14 is glued on. Glue is an adhesive. Further, examiner also notes that Col 4 lines 45-53 teach that glue can leak into the hollow body after the inserts (stones) are placed inside, and cause stones that are intended to be loosely held to be glued to the bottom structure of the cavity, which is considered the support member. It does not matter that this is not the desired effect. Thus the decorative insert(s) are fixed within the base member hollow interior and viewable.

Re claim 136: Fig 4 shows the support member to be round in cross section or perimeter, which examiner considers plate-shaped.

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Re claim 139: Karmeli teaches the method of constructing a decorative jewelry item comprising:

providing a base member with hollow interior, top with opening, bottom, and sidewall (Fig 1B, 2,4, and 5) (top and bottom are considered to be areas).

providing a decorative inert smaller than said opening, inserted thru opening into hollow interior and positioned entirely below top (col 3 lines 45-62, Figs 4 and 5)

placing decorative inert into hollow base through said top opening and entirely positioned below top, whereby said insert is viewable through said top opening (col 3 lines 45-62, Figs 4 and 5, col 3 lines 40-44, col 1 lines 32-33). Fig 5 shows a plurality (3) inserts.

Re claim 140 and 146: Col 2 lines 7-8 discloses both the method and structure that the decorative insert (one or more inner stones) may be loosely or **firmly held** within the body cavity. **Firmly held** inherently teaches that the decorative member is fixed to the interior. Col 3 lines 51-55 teach that the inner stones may be set in a gold setting prior to insertion into the hollow base member to adjust the stone/insert to the desired height relative to the sidewalls, and the actual lower stone portion 18 can be considered the support member. Further, examiner also notes that Col 4 lines 45-53 teach that glue can leak into the hollow body after the inserts (stones) are placed inside, and cause stones that are intended to be loosely held to be glued to the bottom of the cavity, which is considered the support member. It does not matter that this is not the desired effect. Thus the decorative insert(s) are fixed within the base member hollow interior and viewable. Fig 3 shows the inserts (with settings) to be plate shaped.

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Re claim 147: Fig 3 shows the inserts to have faceted tops and a substantially flat bottom.

Re claim 141: Karmeli has taught that stones can be loosely or firmly held. Col 4 lines 45-53 teach that the glue can leak into the hollow body after the inserts (stones) are placed inside, and cause stones that are intended to be loosely held to be glue to the bottom of the cavity, which is considered the support member. It does not matter that this is not the desired effect.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 131-134, 136-137, 139-142, 146 rejected under 35 U.S.C. 103(a) as being unpatentable over Edmark USP 5355698.

Re claim 131 and 139 and 146: Edmark teaches a decorative jewelry item and method for constructing said decorative jewelry item, comprising:

a base member 12 with hollow interior, top with opening, bottom, and sidewall 20 (Fig 1) (top and bottom are considered to be areas).

a decorative inert 14 smaller than said opening, for being inserted thru opening into hollow interior and positioned entirely below top (Fig 1)

said decorative insert fixed within said hollow base, said insert is viewable through said top opening (Fig 1). Col 3 lines 7-24 teach both the method and structure that the decorative insert 14 is fixed within the body cavity.

However, Edmark does not teach that the insert is entirely below the top of the base member. Examiner takes Official Notice, as documented by Applicant's admitted prior art from the Fancy Catalogue item 11111 and the Rudolf Erdel necklace submitted with the IDS that it is well known to have decorative inserts positioned entirely within a base member. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Edmark before him at the time the invention was made, to modify Edmark as is well known in the art, to have decorative insert positioned entirely within a base member. One would have been motivated to make such a combination because this is one of several decorative alternatives, different without an inventive distinction, which would be selected to protect the insert from damage or protect the user's clothing from being damaged by the insert surface, depending on the type of insert and desired decorative effect.

Further Re claim 146: Fig 1 shows the support member 22 to be thinner in depth than the support's diameter or perimeter's length, which examiner considers to be plate-shaped. The upper surface is decorative by definition in col 2 lines 66-68: "decorative piece 14..having a decorative design formed thereon"

Re claims 132-133, 140, 141: Fig 1 and col 3 lines 7-24 disclose both the method and structure that the decorative insert includes a support member 22 fixed to said base within said hollow interior, and the decorative insert is captured within said base

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member between said base member top and said support member. The connection of the male and female snap members is considered a swaging process of affixing, and examiner notes that col 3 lines 15-24 teach that any connection means known in the art, including a post and clasp, or dowel and pin (Clamping) can be used.

Re claim 134 and 142: Fig 1 shows the decorative item with a "plate-shaped" top and rear projecting pin 28 and a support member with a hole therethrough 30 for receiving pin. Examiner notes that although it is not explicit that the support member has the hole therethrough, an alternative coupler of a threaded screw and matching threaded opening is taught in col 3 line 19-20. The connection of the male and female snap members is considered a swaging process of affixing, and examiner notes that col 3 lines 15-24 teach that any connection means known in the art, including a post and clasp, or dowel and pin (Clamping) can be used.

Re claims 136-137: Fig 1 shows the support member 22 to be thinner in depth than the support's diameter or perimeter's length, which examiner considers to be plate-shaped. The plate shaped member has a hole therein through which said pin may pass.

8. Claim 135 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edmark in view of Cheng USP 5289700. As discussed above, Edmark teaches all the elements, including a pin which is rotatable in said support member (inevitably taught by a round pin in a round hole), but does not disclose a pin that is slidably mounted in the hole in the support member with a retainer affixed to said pin below said support member. Cheng discloses a decorative jewelry item, wherein a rear-projecting pin 17 is

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fixed within said hollow base by a retainer 14 below said support member 11 and said pin is slidable to a limited extent (Figs 3A-3C). Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Edmark and Cheng before him at the time the invention was made, to modify Edmark as taught by Cheng, to have decorative insert slidably connected to the support by a rear projecting pin with a retainer affixed below the support member, in order to allow the decorative jewelry to be slightly adjusted to better conform to the wearers taste and comfort, as taught in col 3 lines 12-16. One would have been motivated to make such a combination because this would allow user-customization for appearance, which could be important when the decorative insert is smaller than the base member and would allow different sized inserts to be positioned at different "heights" depending on their size and shape, to best coordinate with the base.

9. Claim 145 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edmark in view of Santosuosso USP 1854958. As discussed above, Edmark teaches all the elements, but does not disclose a multiple segmented base member and a plurality of inserts. Santosuosso discloses a decorative jewelry item, wherein a base member 1 is divided into a plurality of segments 2 in Fig 4. A plurality of decorative inserts 9 is shown in Fig 2. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Edmark and Santosuosso before him at the time the invention was made, to modify Edmark as taught by Santosuosso, to have a base with a plurality of segments, and a plurality of decorative inserts, in order to allow the decorative jewelry to contain multiple decorative inserts. One would have been

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motivated to make such a combination because this would allow jewelry to use multiple smaller stones to make up a larger piece of jewelry, or allow multiple decorative pieces to be used in a pattern or to form jewelry larger than the size of an individual insert.

Allowable Subject Matter

10. Claims 143-144 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Edmark is the closest art of record, but examiner notes that Karmeli (applied), Huang USP 5235824, and GB 1200257 were also seriously considered. Simmons, USP 2273227 teaches a base member that is segmented and an insert that is segmented. However, the insert is not insertable through the top opening, nor would it work if it were modified to be top entry. Changing the entire structure to accommodate a top-inserted multiple segmented insert in a multiple segmented base would involve no motivation other than hindsight. Thus the prior art of record, taken as a whole, does not teach or make obvious a base member that is segmented with a multiple segmented hollow interior and a multiple segmented decorative insert configured and sized to be inserted through the top opening of the multiple segmented base member.

Response to Arguments

12. Applicant's arguments with respect to claims 131-137 and 139-142 and 145-147 have been considered but are moot in view of the new ground(s) of rejection.

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13. The objections to the priority claim, oath, drawings, and specification are canceled in view of the arguments and amendment of 2/11/2005. However, as noted above, the objection to "plate-shaped" is repeated.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Examiner
Art Unit 3677

A handwritten signature in black ink, appearing to read 'Katherine W Mitchell', written in a cursive style.

Kwm
5/8/2005



REPLACEMENT SHEET 1/2

12/16

OK
KM
5/9/05

FIG. 60

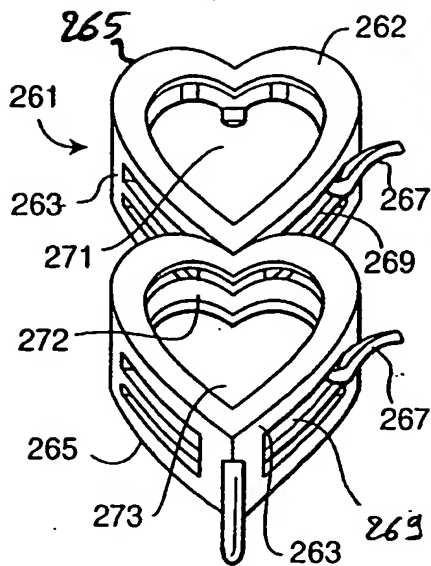


FIG. 61

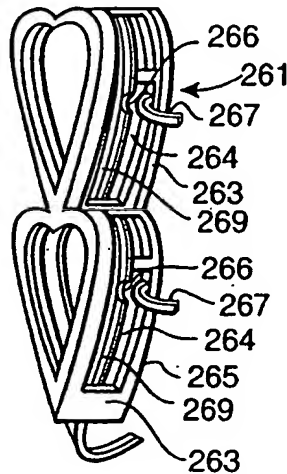


FIG. 62

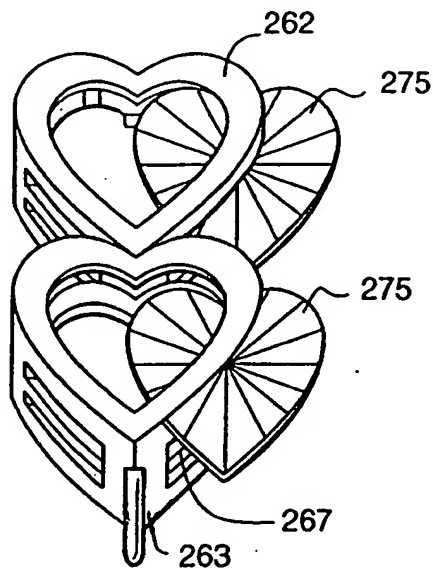
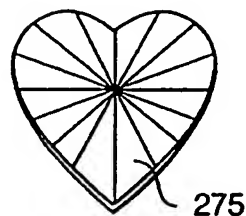


FIG. 63

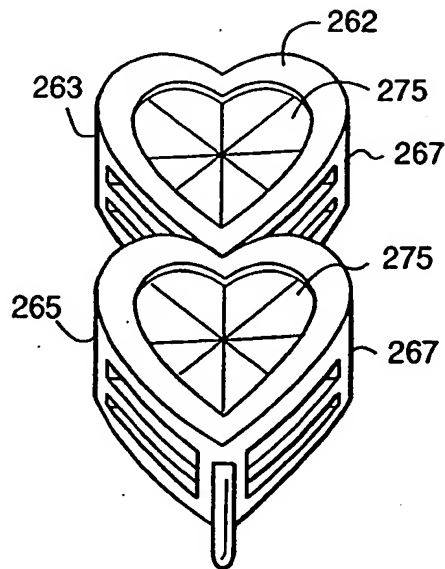


FIG. 64

OK
KWM
5/9/05

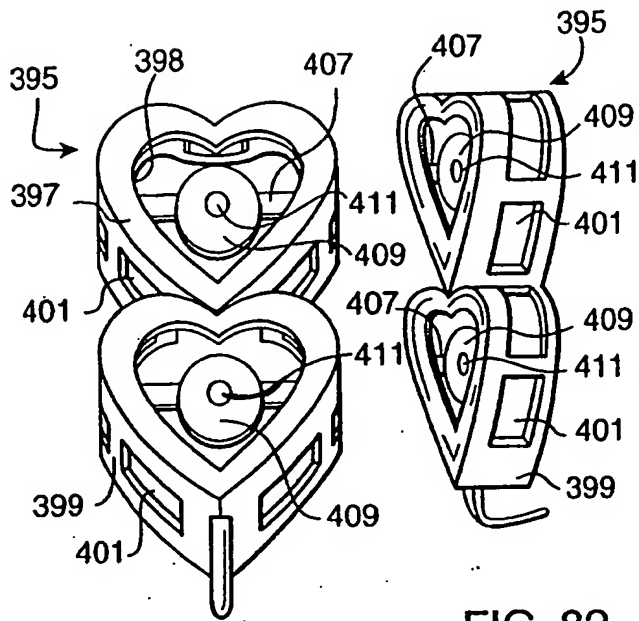


FIG. 81

FIG. 82

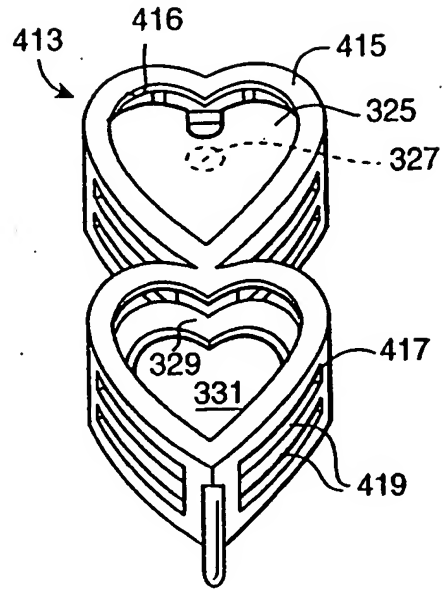


FIG. 83

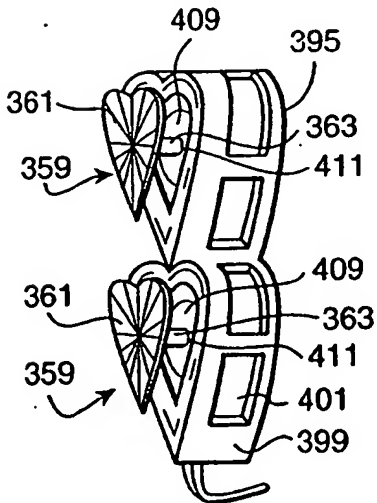


FIG. 84

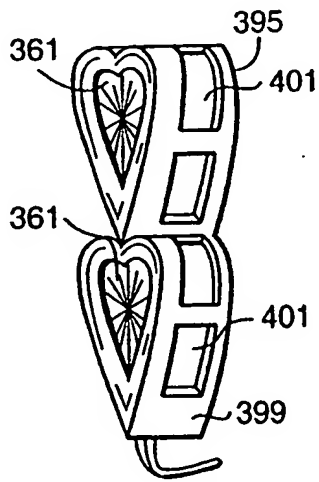


FIG. 85

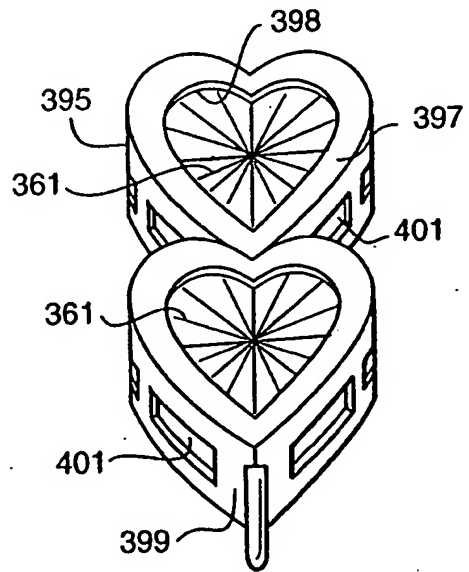


FIG. 86